



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,597	05/22/2000	John J. Voorhees	1718-009A	1700

7590 03/27/2002
BRADLEY N. RUBEN
463 FIRST ST., SUITE 5A
HOBOKEN, NJ 07030-1859

EXAMINER

KIM, VICKIE Y

ART UNIT PAPER NUMBER

1614

DATE MAILED: 03/27/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/576,597

Applicant(s)

VOORHEES ET AL.

Examiner

Vickie Kim

Art Unit

1614

--The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

THE REPLY FILED 08 March 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): 112 rejection.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,3-5,8,9 and 21.Claim(s) withdrawn from consideration: 10-20.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
10. ☐ Other: _____


WILLIAM R. A. JARVIS
PRIMARY EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because: Applicants argument has been considered carefully. Firstly, regarding the finality of previous rejection, the finality is proper because the scope change was made in the claim. Applicants argument is mostly correct, however applicants have failed to mention about newly presented limitation changes(e.g. "non antioxidant") that has not been mentioned earlier and narrows the scope. In addition to that, the scope of claim has been changed due to the deletion of term "antibacterial". Thus the finality of previous rejection is proper. Secondly, regarding remarks on art rejection, applicants argument is now persuasive because all the critical elements are taught and obvious over the cited references of the prior art wherein the emphasis should be made on the claimed subject matter that is the composition. The claims read on a composition comprising non-retinoid, non-antioxidant MMP inhibitor(e.g. AP-1 inhibitor) and the secondary active agent (e.g. retinoids). Since the cited references teach a pharmaceutical composition containing these compounds required by the instant claims, whether the preamble(effectiveness for acne treatment) is taught or not, the claims are met. As long as the composition of the cited references(including modified composition) teach all the elements and the same structure, then it should possess the said feature inherently. Thus art rejection is proper and maintained .